REMARKS

Claims 1-84 were pending. Claims 1-84 were rejected. Claims 1-15, 18-25, and 28-32 are amended herein. Support for the amendment can be found in the specification as originally filed, particularly on pages 8, 16, and 20-22. Care has been taken to avoid introducing new matter. 16-17 and 33-84 are cancelled. By this Amendment, claims 1-15 and 18-32 are pending with claim 1 being the base claim for all pending claims.

Regarding Claim Rejections

Rejections with respect to cancelled claims 16-17 and 33-84 are submitted to be moot. Claims 1, 5-13, 18-24, and 29 were rejected under 35 U.S.C. § 102(e) as being anticipated by Lawrence et al. (U.S. Pat. No. 6,289,342, hereinafter referred to as "Lawrence"). Dependent claims 2-4 and 30-32 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Lawrence in view of Johnson et al. (U.S. Pat. No. 6,553,385, hereinafter referred to as "Johnson"). Dependent claim 14 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Lawrence in view of Kavner (U.S. Pat. No. 6,366947). Dependent claims 15 and 25-28 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Lawrence. The rejections are respectfully traversed. Reconsideration is respectfully requested in view of the following remarks and the amendments to the claims submitted herewith. The patentability of the present invention is first discussed below with respect to the base claim 1.

> "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Lawrence's invention is hereby distinguished at least because Lawrence does not anticipate or suggest, *inter alia*, evaluating a tense related to the identity and contact information of senior business managers. In fact, Lawrence specifically teaches away from business

information because only documents that are verified as valid research documents are processed [col. 8, lines 53-54]. Non-research documents such as business documents are deemed invalid and skipped [*id.*].

As a whole, Lawrence teaches an autonomous citation indexing (ACI) system that creates a citation index from literature in electronic format [Abstract; col. 5, lines 50-51; col. 6, lines 27-30]. This ACI system does NOT compile business data. One skilled in the art would have recognized that there exist distinct differences between indexing citations of literature publication and compiling identity and contact information of senior business managers. Each faces different challenges and solves different problems. For example, the ACI system is capable of creating citation index from indexed papers but is not capable of identifying and extracting author identification, affiliations, and so on from arbitrary articles [col. 10, lines 23-49]. At best, the ACI system provides a link to the original Web page where an arbitrary article was located [*id.* at lines 49-51]. Lawrence does not teach or suggest locating files containing identity and contact information of senior business managers on corporate websites, magazine websites, newspaper websites, press releases on the Web, professional websites, association websites, etc., as taught and claimed in the present invention.

Moreover, Lawrence also does not teach or suggest evaluating a tense, for instance, a future or past tense, related to the identified papers, journals, or author. This is because currency (or "recency" as defined on page 3 of the specification) of the identified information is not material to the ACI system. While a user of the ACI system may be interested in papers published by a certain author in a particular year, the ACI system itself does not care how fresh or recent the author's information is, notwithstanding the lack of accuracy thereof. Further, for research purposes, it would be logical to keep all past publications. This is supported by the fact that in the ACI system papers, journals, authors and so forth are ranked by the number of citations [col. 6, lines 30-31]. Thus, there is no need to evaluate a tense or to discard papers, journals, authors and so forth associated therewith.

Contrastingly, as taught in the present application and originally claimed in claims 16-17, it is pertinent that the senior management information be current. Once the tense is identified

and evaluated, the present invention determines whether or not to include or discard the senior management information associated with that particular tense. The examiner cited column 9, lines 7-9, and column 15, line 59, of Lawrence to reject claims 16-17. Column 9, lines 7-9, teaches that recorded words are stemmed using Porter's algorithm to combine different forms of the same word. Column 15, line 59, teaches using semantic information such as author, year, title to refine the normalization algorithm. Neither one teaches or suggests evaluating a tense related to the author, year, or title and neither one teaches or suggests determining whether to keep include or discard the author, year, or title based on the evaluation. What is more, it would not have been obvious to one skilled in the art at the time of the invention to modify Lawrence and somehow arrive at the invention as claimed because Lawrence teaches away from discarding papers, journals, authors and so forth, as discussed above. Accordingly, it is submitted that original claims 16-17 recite subject matter not reached by the closest prior art of record. Claim 1 is particularly amended herein to incorporate subject matter recited in claims 16-17 and therefore is submitted to be allowable. Claims 16-17 are correspondingly cancelled herein.

As particular discussed in the present application, the claimed invention advantageously enables one to compile interested business data such as senior management information from virtually all files available on the Web in a cost effective and time effective manner. As discussed above, the ACI system of Lawrence is not designed for and is incapable of compiling the most up-to-date business data obtained from a distributed computer system such as the Internet, notwithstanding the ACI system's inability to obtain author information such as identity and affiliation from arbitrary files on the Web. As discussed below, the secondary references, Johnson and Kavner, unfortunately do not and cannot fill the void of Lawrence.

Johnson teaches a framework for extracting information from natural language documents. In particular, Johnson teaches an *optional* confidence measurement that can be used to add or ignore a category to a current result set [col. 10, lines 20-22]. Johnson's optional confidence measurement at best meets the term but not the heart of the claimed invention. Following the examiner's logic, because the claimed features distinguish the invention over prior art as

discussed above, the teachings of Lawrence could not and would not have performed the invention as claimed with any terminology used by Johnson or by others. Therefore, it would not have been an obvious matter of design choice to modify Lawrence with Johnson.

Similarly, the combination of Lawrence and Kavner, as a whole, does not teach or suggest the invention as claimed. Further, neither Lawrence nor Kavner suggests any motivation or desire to combine. The examiner argued that it would have been obvious to one having ordinary skill in the art at the time of the invention was made to modify Lawrence with Kavner because "*it would enhance the thoroughness of the search results by downloading all the associated hypertext links that are on the present page.*" This assertion is not supported by the combined teachings of Lawrence and Kavner because Kavner's statistical engine for predicting what links a *user* might select next is practically useless in Lawrence's *autonomous* citation indexing system. The ACI system does support search by keyword and browsing by citation links through a web browser interface. However, users of the ACI system search and browse through the ACI system's database and not directly the Internet.

More specifically, a user submits a search query to the query processing module [col. 10, lines 54-55]. The query processing module searches the database and returns a list of articles that match the query [col. 10, lines 66-67]. The user then browses the articles by following the links between the articles made by citations [col. 11, lines 1-2]. In other words, there is no need to download and/or to predict what to download because all of the associated hypertext links on the search result page should have and would have already been indexed and stored in the database. Further, having a statistical engine as disclosed by Kavner to predict what links the *user* might select next would not enhance the thoroughness of the search results because the ACI system searches the Internet *autonomously*. It is therefore submitted that it would not have been obvious to one having ordinary skill in the art at the time of the invention was made to modify Lawrence with Kavner.

Since obviousness cannot be established absent some teaching, suggestion, or incentive supporting the modification/combination, the examiner has not established a *prima facie* case of obviousness (ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F. 2d 1572, 1577,

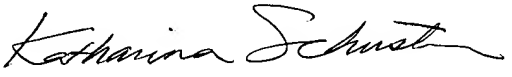
221 USPQ 929, 933 (Fed. Cir. 1984)). Absent such a showing in the prior art, the examiner has impermissibly used the applicant's teaching to hunt through the prior art for the claimed elements and combine them as claimed (see In re Vaeck, 947 F. 2d 488, 20 USPQ 2d 1438 (Fed. Cir. 1991); In re Bond, 910 F. 2d 831, 15 USPQ 2d 1566 (Fed. Cir. 1990); In re Laskowski, 871 F. 2d 115, 117, 10 USPQ 2d 1397, 1398 (Fed. Cir. 1989)). The use of hindsight is never permissible to establish obviousness.

Conclusion

For the foregoing reasons, it is respectfully submitted that the present invention is patentably distinct from, not anticipated by, and unobvious in view of Lawrence, Johnson, and Kavner, individually and in combination. It is further respectfully submitted that independent claim 1 recites subject matter not reached by the closest prior art of record under 35 USC §§ 102(e) and/or 103(a). Accordingly, independent claim 1 is submitted to be patentable. Reliance is placed on *In re* Fine, 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988) and *Ex parte* Kochan, 131 USPQ 204 (Bd. App. 1960) for allowance of the dependent claims 2-15 and 18-32, since they differ in scope from their parent independent claim 1 which is submitted to be patentable.

This Response/Amendment is submitted to be complete and proper in that it places the present application in a condition for allowance without adding new matters. Since the examiner has done a thorough search in the first Office action in light of the entire application disclosure and claims, no new search would be necessary. Favorable consideration and a Notice of Allowance of all pending claims are therefore earnestly solicited. The examiner is sincerely invited to telephone the undersigned at 650-331-8413 for discussing an examiner's Amendment or any suggested actions for accelerating prosecution and moving the present application to allowance.

Respectfully submitted,



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